

Application No.: 10/643395  
Docket No.: FA1059USNA

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REMARKS

Claims 1-9 are pending in the present application, and were made subject to a restriction requirement as follows:

Group I: Claims 1-7, and 9, drawn to a coating composition and process thereof; and  
Group II: Claim 8, drawn to a coated product.

By telephone, Applicants elected Group I claims 1-7 and 9. Applicants affirm election of Group I claims 1-7 and 9 for examination. Claim 8 is withdrawn from consideration.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 6, which now recites the "electrodepositing a CED coating layer on an electrically conductive substrate connected up as the cathode from the CED coating agent of claim 1." This claim amendment is supported by the specification on page 8, lines 21-24. Reconsideration of the rejection is requested.

Claims 1-7 and 9 are rejected under 35 U.S.C.102(e) as anticipated by or, in the alternative, under 35 U.S.C.103(a) as obvious over McCollum et al. (US 2003/0054193 A1). Applicants respectfully traverse the rejection.

Applicants' claimed invention is directed to waterborne cathodic electrodeposition coating agents that comprise at least one bismuth salt selected from the group consisting of bismuth hydroxycarboxylic acid salts and bismuth sulfonic acid salts in a quantity of 0.1 to 2.5 wt-%, calculated as bismuth and relative to the resin solids content, together with at least one compound selected from the group consisting of yttrium and neodymium compounds in a quantity of 0.1 to 1 wt-%, calculated as metal and based on resin solids content in waterborne cathodic electrodeposition coating agents. Consequently, the bismuth salt is selected from the group consisting of bismuth hydroxycarboxylic acid salts and bismuth sulfonic acid salts, rather than being any bismuth salt. Further, the bismuth salt of the present invention is used together with yttrium and/or neodymium compound.

The Examiner points to para 130-132 with the argument that McCollum et al. teaches the use of at least one source of a metal selected from rare earth metals, yttrium, bismuth, zirconium, tungsten and mixtures thereof. The at least one source of metal typically is present in the electrodepositable composition in an amount of 0.005 to 5 % by weight metal, based on the total weight of resin solids in the coating composition. The Examiner's argument is that the selection of the combination of bismuth with rare earth metal (yttrium or neodymium) would be a selection that would be made within the level of ordinary skill in the art.

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The claimed invention is both novel and non-obvious over McCollum et al. The present invention is not anticipated by McCollum et al. because the cited reference is silent with regard to the specific claimed combination of bismuth with yttrium, bismuth with neodymium or bismuth with yttrium and neodymium. However, these specific elements are present in Applicants' claimed invention.

McCollum et al. is also silent with regard to the specifically selected bismuth salts, namely bismuth hydroxycarboxylic acid salts and bismuth sulfonic acid salts. Furthermore, McCollum et al. is also silent with regard to the quantity of the bismuth salt as well as to the quantity of the yttrium or neodymium compound. Consequently, each and every element of Applicants' claimed invention is not disclosed by McCollum et al. Accordingly, withdrawal of the rejection under 35 U.S.C. 102(e) is proper.

Applicants' claims invention as recited in claims 1-7 and 9 is also non-obvious over the cited reference. McCollum et al. provides no motivation or suggestion for the skilled person to make the specific selection of specific bismuth salts, in the recited quantity, in combination with the yttrium and/or neodymium compound in the specified quantity. In para 130 McCollum et al. only states that any of the previously described electrodeposition coating compositions can further comprise at least one source of a metal selected from rare earth metals, yttrium, bismuth, zirconium, tungsten, and mixtures thereof. Then McCollum et al. states the quantity of the at least one source of metal as typically present in an amount of 0.005 to 5 % by weight metal, based on the total weight of resin solids in the coating composition and that yttrium is typically employed. In para 131 examples for suitable yttrium compounds are given. In para 132 suitable rare earth metal compounds are exemplified.

In para 133 methods of incorporation of the metals into the electrodepositable coating compositions are explained. It is interesting to look at para 134 where it is stated that the electrodeposition coating compositions can contain yttrium, bismuth, zirconium, tungsten, or a rare earth metal as the sole corrosion inhibiting inorganic component or can be supplemented with other corrosion inhibiting inorganic or organic components such as calcium. Assuming a prima case of obviousness has been made, Applicants rebut the Examiner's rejection by pointing out that McCollum et al. teaches away from combinations of the metals. Indeed, McCollum et al. suggests that the metals named as a possible constituent of the McCollum electrocoating compositions serve as corrosion inhibitors.

Applicants point out that the only examples in the McCollum reference which comprise some of the metals named in the specification are examples 7a-j on page 29/30.

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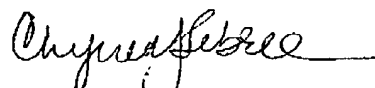
Each of the examples contains a rare earth element, including example 7g comprising neodymium. In para 229 it is stated that the inclusion of a rare earth metal in an electrodepositable coating composition of the present invention provides improved scribe creep corrosion resistance over an analogous composition which does not contain a rare earth metal. Indeed this statement admits that McCollum is directed to improvement of scribe creep corrosion, which is a different technical concept from edge corrosion. In view of the foregoing, reconsideration and withdrawal of the rejection made under 35 USC 103(a) is requested.

The Examiner has provisionally rejected claims 1-7 and 9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-6 and 8 of co-pending Application No. 10/668,956 in view of McCollum et. Applicants acknowledge the Examiner's rejection as well as the fact that the claims have not been found allowable in the co-pending application or in the present case. Applicants agree to address the rejection when and if claims are found allowable.

#### CONCLUSION

In view of the foregoing, Applicants request reconsideration and allowance of the pending claims. If anything further is needed to advance prosecution of the present application, the Examiner is invited to contact Applicants' attorney using the contact information provided below.

Respectfully submitted,

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